

REMARKS

Upon entry of this amendment, claims 1-3, 8, 10, 12 and 17-19 are pending. Claims 9 and 11 are canceled without prejudice. Applicants reserve their right to prosecute subject matter of canceled claims in subsequent applications.

Claim 1 has been amended to recite an oligonucleotide primer consisting of SEQ ID NO: 27 and deleted recitation of "selected from the group" since a group of oligonucleotides is no longer recited.

Claim 2 has been amended to recite a pair of oligonucleotide primers, wherein said pair consists of two oligonucleotides consisting of SEQ ID NO:27. Support is in the claim as originally filed and in the specification on page 9, lines 21-26.

Claim 3 has been amended to delete "a)" since there is only one pair of primers now listed.

Claim 12 has been amended to recite the method of claim 10, wherein said pair of primers consists of SEQ ID NO:1 and SEQ ID NO: 27 and delete dependence according to claim 3 to put the claim in proper dependent format as pointed out by the Examiner.

No new matter has been added by these amendments.

Claim Interpretation

Claim 2 has been amended to recite a pair of oligonucleotide primers consisting of SEQ ID NO:27, as interpreted by the examiner.

Claim Objections

Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim refers to two set of claims to different features.

Claim 12 has been amended to be dependent only on claim 10 and to recite the pair of primers consists of SEQ ID NO:1 and 27.

Claim 11 has been objected to a being redundant to claim 10. Claim 11 has been canceled, thereby making this objection moot.

Claim Rejection under 35 USC § 112, Second Paragraph

Claims 9 and 11 are rejected under 35 USC 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Applicants respectfully disagree with this rejection. However, claims 9 and 11 have been canceled, making this rejection moot.

Claim Rejection under 35 USC § 112, First Paragraph

Claims 1-3, 8-11, and 17-19 are rejected under 35 USC § 112, first paragraph, as allegedly failing to comply with the enablement requirement. In particular, the Office Action questions how the primers SEQ ID NO:1 and SEQ ID NO:27 could be specific to detect the fungus *Cladosporium carpophilum*.

Applicants respectfully disagree with this rejection.

Enablement of a disclosure “is not precluded by the necessity for some experimentation such as routine screening.” In re Wands, 858 F.2d 731, 736-7 (Fed. Cir. 1988) (citations omitted). The experimentation necessary must not be undue. Id. At 737. Undue experimentation is experimentation that would require a level of ingenuity beyond what is expected from one of ordinary skill in the field. Fields v. Conover, 170 USPQ 276, 279 (CCPA 1971). The factors that can be considered in determining whether an amount of experimentation is undue have been listed in Wands, 858 F.2d at 737. Among these factors are: the amount of effort involved, the guidance provided by the specification, the presence of working examples, the amount of pertinent literature and the level of skill in the art. The test for undue experimentation is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine. Id.

The relevant inquiry for determining whether the scope of the claims is commensurate with the specification is “whether the scope of enablement provided to one of ordinary skill in the art by the disclosure is such as to be commensurate with the scope of protection sought by the claims.” In re Moore, 439 F.2d 1232, 1236 (CCPA 1971) (emphasis added). “A patent need not teach, and preferably omits, what is well known in the art.” Hybridtech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), cet. Denied, 480 U.S. 947 (1987).

Applicants respectfully point out to the Examiner that *Cladosporium carpophilum* is also known as *Venturia carpophila* as stated in the Specification on page 20, lines 13-14 and on Exhibit A the Species Fungorum-Fungal Species synonymy that is available through the Genbank Taxonomy database. The species synonymy shows that the current name for the fungus is *Venturia carpophila* and that it has also been known as *Cladosporium carpophilum*, among other names listed. Therefore, the PCR primer of SEQ ID NO:27 will be specific for *Cladosporium carpophilum* as described in the specification.

Since use of the primer of SEQ ID NO:27 is specific to the fungus *Cladosporium carpophilum*, aka *Venturia carpophila*, then the primers, methods, and kits are enabled for use in detection of this fungus. Therefore, one skilled in the art would be able to determine the presence/absence of the fungus in a plant sample without undue experimentation because the claimed primers are specific to this fungus. The above remarks and amendments overcome this rejection, and Applicants respectfully request its withdrawal.

Conclusion

The above remarks and amendments overcome the objections and rejections. The Applicants respectfully request allowance of this application.

Respectfully submitted,

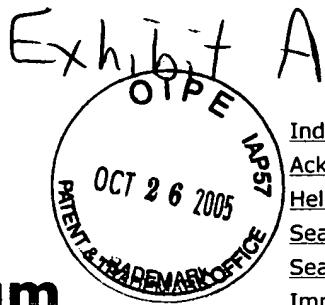
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Species Fungorum



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Species Synonymy See Note

Current Name:

Venturia carpophila E.E. Fisher, *Trans. Br. mycol. Soc.* **44**(3): 339 (1961)

Synonymy:

Cladosporium carpophilum Thüm., *Öst. bot. Z.* **27**: 12 (1877)

Fusicladium amygdali Ducomet, (1907)

Fusicladium carpophilum (Thüm.) Oudem., *Verh. K. Akad. Wet.*, tweede sect.: 388 (1900)

Fusicladium pruni Ducomet, (1907)

Fusicladosporium carpophilum (Thüm.) Partr. & Morgan-Jones, (2003) Recent record: see *Index of Fungi*

Megacladosporium carpophilum (Thüm.) Vienn.-Bourg., *Les Champignons Parasites des Plantes Cultivees* **1**: 489 (1949)

Synonymy/Taxonomic opinion contributor(s):

IMI (2004); CPC

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